

### REMARKS

Claims 11-36, 49 and 51 remain in the case, with Claims 11-30 and 32 being withdrawn from consideration.

### Formal Matters

For the record, there are no objections or rejections under 35 U.S.C. 112 outstanding.

### Rejections Under 35 USC 103

Claims 31, 33-36, 49 and 51 stand rejected over EPO 0503219 and U.S. 5,538,664 and U.S. 5,638,569 and U.K. 1,357,323, for reasons of record at pages 4-7 of the Office Action.

Applicants respectfully traverse the rejections on this basis.

As evidenced by the Examiner's comments at pages 2-3, it is respectfully submitted that the Examiner's interpretation of the relevant case law is somewhat at odds with that of Applicants' Attorney, undersigned. Indeed, the position can be reasonably argued that it is the Examiner who is parsing the cited documents to arrive at a hindsight reconstruction of the present invention. It is submitted that this is impermissible under the Federal Circuit's decision in *In re Dembiczak*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992).

As earlier argued, the present invention relates to the field of superabsorbent materials used in cleaning operations with detergent compositions.

However, it is more than that. Applicants have unexpectedly discovered that if the detergent compositions contain too much detergent surfactant, there is an interference with the operation of the superabsorbent material. This "newly-discovered problem/solution" issue under section 103 is fully discussed in the previous responsive amendment. (Controlling case law and arguments continue to apply, but will not be repeated here, for the sake of brevity.)

Given the foregoing "problem/solution" issue, it is submitted that the question necessarily arises as to whether a *prima facie* case of obviousness has, in fact, been established under the guidelines of case law and MPEP 2143, which states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [Emphasis supplied]

To briefly re-state Applicants' position.

1.) The '569 patent teaches superabsorbent materials in mop heads. However, nothing therein teaches or suggests the problem associated with the use of such mop heads with detergent solutions containing high levels of detergent surfactants. This problem was discovered by the present Applicants.

2.) It necessarily follows that, '569 does not suggest any solution to the problem. Said another way, '569 deals only with the mop head and is entirely silent regarding the appropriate range of surfactants for use with the mop head.

3.) To fill that lacuna, one has to turn to the literature. However, absent some appreciation of the problem discovered by Applicants herein, to what literature does one turn? Of all the hard surface cleaning compositions known in the art, why would one turn to the cited EPO '219, U.S. '664 and U.K. '323 documents, if it were not for the hindsight gained by Applicants having first discovered the surfactant problem?

4.) Moreover, even if one were to turn to U.K. '323, as suggested by the Examiner's grounds for rejection, the surfactant levels disclosed therein are too high to solve the problem. So, in fact, '323 teaches away from Applicants' solution to the problem.

5.) If one were to turn to U.S. '664, one would find a low surfactant level, but would find no basis for selecting such compositions for use in combination with the '569 mop heads containing superabsorbents.

6.) Likewise, turning to EP '219, one finds no basis for selecting the disclosed compositions for use in combination with mop heads containing superabsorbents.

Assuming *arguendo* that all the individual components of the present invention (other than the key recognition of the superabsorbent/surfactant level problem) can be found in the combination of cited documents, the BPAI had held that this is not the test of *prima facie* obviousness under 35USC103. See *Ex parte Hiyamizu*, 10 USPQ2d 1393, 1394 (BPAI 1988).

Moreover, even if, by a hindsight selection of ingredients and ranges taken from all the cited documents, one could arrive at the present invention, it is submitted that this is also not the test of 35USC103. Rather, the issue is what the person of skill in the art would have done, absent Applicants' discovery of the problem herein. It is settled law

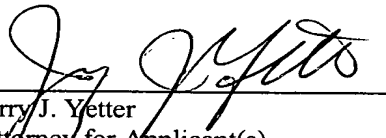
Appl. No. 09/509,603  
Atty. Docket No. 6873  
Amdt. dated 3/11/2004  
Reply to Office Action of 1/12/2004  
Customer No. 27752

that the question of obviousness under §103 is not what the artisan could have done, but rather what would have been obvious for such a person to do. See *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986).

To summarize, it is submitted that the whole of the present invention is neither taught or suggested by the cited combination of documents, as a matter of law. Accordingly, reconsideration and withdrawal of the rejections are requested.

In light of the foregoing, early and favorable action is requested.

Respectfully submitted,  
Policicchio et al.

By   
Jerry J. Yetter  
Attorney for Applicant(s)  
Registration No. 26,598  
(513) 627-1907

March 11, 2004  
Customer No. 27752  
(6873 RCE Response OA 1-12-04)  
Revised 10/14/2003